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No. 95-26

Supreme Court, U. S.

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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN, et al.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC., et al.,
Respondents,

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

BRIEF OF HONEYWELL, INC.
AS AMICUS CURIAE SUPPORTING RESPONDENTS

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**BRIEF OF HONEYWELL, INC.
AS AMICUS CURIAE SUPPORTING RESPONDENTS**

INTEREST OF AMICUS

Honeywell, Inc., participates in high-technology fields in which patents are important. It is currently a party to a patent case (*Litton Systems, Inc. v. Honeywell, Inc.*, Nos. 95-1242, 95-1311 (Fed. Cir.) (pending)) that raises issues related to the issue presented here. For that reason, and because of its continuing interest in the fair, predictable, and proper functioning of the patent system, Honeywell has a strong interest in the outcome of this case.¹

SUMMARY OF ARGUMENT

This Court should affirm the Federal Circuit's holding that the meaning of terms in patent claims does not present a factual issue for juries. To begin with, petitioners' view that a genuine triable dispute can arise about the reasonable understanding of claim terms is simply inconsistent with the substantive patent-law requirement that patent claims, to be valid, must be definite, precise, clear. A judge, after examining the extensive evidence properly considered in discerning a claim's meaning, cannot simultaneously find that there is ambiguity for a jury to resolve (about a truly shared understanding in the relevant skilled community) and that the claim meets the statutory requirement of definiteness. Petitioners' contrary view would defeat the fundamental statutory insistence that a patent give clear warning to the world as to the scope of the protected monopoly.

The Federal Circuit's holding is independently correct because a patent, like a statute but unlike a contract, is an official government act imposing nonconsensual duties on the public at large, charging the public with knowledge of those duties. Interpreting the meaning of the standard of conduct thus created is part of the process of law declaration, providing rules of general application good

¹ Letters indicating the consent of the parties to the filing of this brief *amicus curiae* have been filed with the Clerk of the Court.

against the world, for use by all others working in the area of the patent. And the need to find the relevant community understanding of "technical" terms (read in full context), which may be unfamiliar to some (but not all) judges, makes the task no less one of law declaration than the interpretation of technical terms in statutes or the interpretation of foreign law. By contrast, the factual issue of subjective intent as to meaning, which may be given to juries for resolution in private contract cases where ambiguity exists, is out of place in patent interpretation, as petitioners effectively recognize in downplaying reliance on any contract analogy and insisting that it is an objective, public meaning that is to be discerned in this setting. Determining the meaning of a patent claim, as a duty-imposing government instrument, is not for a jury.

This Court's precedents support the Federal Circuit's ruling. The Court has many times ruled that patent interpretation is for the courts. The few allegedly contrary decisions petitioners cite actually involved not the determination of the meaning of words in a patent claim, but factual findings about the application of patent language after full refinement through interpretation. The role for the latter task was necessarily greater in the pre-1870 era, when "claims" were either non-existent or so brief and imprecise that very little *interpretation* of patent language was relevant to patent litigation. The task of discerning the meaning of patent claims, however, was even then a question of law, and it did not cease to be one when, because of the ever-increasing emphasis on detailed and precise patent claims, it came to play a much more dominant role in infringement suits.

The Federal Circuit's ruling is further supported by the sorts of functional and practical considerations that this Court has found relevant to drawing the law/fact distinction. In particular, assignment of patent interpretation to judges is more in accord with the patent system's demand for precision and uniformity in the government-imposed

obligations created by patents and with the inevitable unimportance of in-court demeanor and credibility determinations in discerning the shared skilled-community understandings of patent language that must, by law, have a definite meaning. Moreover, the patent system cannot sensibly divide the mass of interpretive issues according to whether they are "technical" or "non-technical," or according to the degree of technical knowledge of the particular judges involved. Of course, if the result of the Federal Circuit's ruling is to resolve many cases without need of jury trials, that is hardly a vice, as petitioners appear to suggest; it is, rather, a virtue.

Against this background, petitioners' Seventh Amendment argument effectively dissolves. The argument fails most simply because, for all of the foregoing reasons, patent interpretation properly falls on the law side of the law/fact distinction under the Seventh Amendment. And even if that were not so, this Court has made clear that the jury's ordinary power over facts under the Seventh Amendment does not apply when seemingly factual issues are intermingled with federal rights and judges' determinations are required in order to ensure proper application of federal rights—here, the monopoly rights granted each patentee and the corresponding limitations on the economic rights of others. Finally, petitioners' resort to pre-1791 English law furnishes them no support: the authorities they cite assign various factual questions to juries (*e.g.*, whether a machine was new, whether the description enabled skilled artisans to construct the machine), but they nowhere establish that juries were assigned the task of interpreting the meaning of patent terms, let alone then-nonexistent patent claims.

ARGUMENT

THE FEDERAL CIRCUIT CORRECTLY HELD THAT THE MEANING OF A PATENT CLAIM PRESENTS A LEGAL QUESTION FOR THE JUDGE, NOT A FACTUAL QUESTION FOR THE JURY.

The Seventh Amendment requires a jury trial only of genuine issues of disputed fact, where reasonable minds

can differ. See *Boyle v. United Technologies Corp.*, 487 U.S. 500, 513 (1988); *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657-59 (1935). The interpretation of a patent claim does not present a jury issue, first, because a patent claim, in order to be valid at all, cannot have the sort of ambiguity of meaning that would raise a triable issue and, second, because the interpretation of a patent claim is in any event a legal (not factual) question about the public, objective meaning of a government-imposed general obligation. This Court's precedents, as well as a functional and practical analysis of the law/fact distinction, support this result. And nothing in Seventh Amendment law is to the contrary. The Federal Circuit's ruling should therefore be affirmed.

A. The Substantive Rules of Patent Law Preclude Indefiniteness That Could Create a Genuine Issue of Disputed Fact as to the Meaning of a Patent Claim.

Petitioners' entire argument for assignment of a "factual" issue of meaning to a jury rests on the premise that a judge, after exhausting the usual textual sources for determining meaning, is left with an ambiguity that cannot be resolved. Such an ambiguity, petitioners urge, creates an issue of fact: "what does a patent term mean to one skilled in the art"? Br. 15; Br. 18 (fact issue is "what the claims mean to one 'of skill in the art'"); see also Litton Br. 21 ("what the relevant scientific community would understand a particular term to mean at the time of the patent's issuance"). But as the Federal Circuit explained (*Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (1995)), the substantive rules of patent law require that patent claims be unambiguous. Thus, no jury issue as to the meaning of a valid patent claim can properly arise.

1. The Federal Circuit's ruling rests squarely on longstanding substantive rules of patent law. Section 112 of the current statute, enacted in 1952, begins by declaring that a patent "specification" must "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and

exact terms as to enable any person skilled in the art . . . to make and use the same." 35 U.S.C. § 112 (paragraph 1). It then adds: "The specification shall conclude with one or more claims particularly pointing out and *distinctly claiming* the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (paragraph 2) (emphasis added).²

The statute thus imposes two quite separate requirements: enablement and definiteness. See D. Chisum, *Patents* § 8.03[2] (1995) ("Definiteness Distinguished from Enablement"). While the enablement requirement "means that the *specification* must describe the manner of making and using the invention in such clear terms as to enable any person skilled in the art to make and use it," the definiteness requirement "means that the language of the *claims* must *clearly* set forth the area over which the applicant seeks exclusive rights." *Ibid.* (emphasis added). This latter requirement, in the second paragraph of 35 U.S.C. § 112, "is essentially a requirement for *precision* and *definiteness* of claim language." *Ibid.*; see, e.g., *Hybritech Inc. v. Abbott Laboratories*, 849 F.2d 1446, 1453 (Fed. Cir. 1988); *In re Borkowski*, 422 F.2d 904, 909 (C.C.P.A. 1970).³ It has thus repeatedly been recognized that a patent *claim* cannot validly cover anything it does not clearly and unambiguously cover. See, e.g., *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938); *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942) (to be valid, claims must "clearly distinguish what is claimed

² The statute's provision on infringement, 35 U.S.C. § 271, then creates liability if any person (without authority) "makes, uses or sells any patented invention" (in this country during the term of the patent), the "invention" having been defined by the patentee in the "claims."

³ This requirement of definiteness of meaning is embodied in the rules and guidelines of the Patent and Trademark Office as well. See, e.g., 37 C.F.R. § 1.75; Manual of Patent Examining Procedure §§ 608.01(o) (meaning must be "apparent" and "insure certainty"), 608.01(v) (meaning of nonproprietary name must be defined in "precise and definite" manner or already "well-known and satisfactorily defined in the literature").

from what went before in the art and clearly circumscribe what is foreclosed from future enterprise"; forbidding "zone of uncertainty"); *Markman*, 52 F.3d at 986 (ambiguity may invalidate patent); *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870, 874-75 (Fed. Cir. 1993) ("clear and definite meaning" required); *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1218 (Fed. Cir.), *cert. denied*, 502 U.S. 856 (1991) ("When the meaning of claims is in doubt, . . . they are properly declared invalid."); notes 17, 18, *infra*.⁴

Under these substantive principles of patent law, petitioners' premise is self-defeating. If there is a common community understanding of the meaning of a term in a patent claim, as there must be for a patent claim to be *valid*, there cannot be an ambiguity, unresolvable on the full record available to the judge, leaving a genuine factual issue as to meaning. If there were such an ambiguity, then the patent-infringement plaintiff would already have lost, because the claim cannot meet the precision requirement that "one skilled in the art would understand the bounds of the claim when read in light of the specification." *Miles Laboratories*, 997 F.2d at 875.

After all, "ambiguity" cannot be found until after the court, following the normal rules of construction, has "seiz[ed] every thing from which aid can be derived" (*Smith v. United States*, 113 S. Ct. 2050, 2059-60 (1993), quoting *United States v. Fisher*, 6 U.S. (2 Cranch) 358, 386 (1805)), which, in the patent setting, always includes the other claims, the patent specification, the prosecution history, and the elaborate, established rules of patent construction and may (though need not) also include helpful texts and live testimony. See, e.g., *Graham*

⁴ Indefiniteness need not lead to invalidation of the whole patent claim. If a claim is ambiguous because one (narrow) application is definitely covered but a second (broader) application is uncertain, a "saving" construction—consistent with the principle that the courts "ought to give a favorable construction, so as to sustain the patent if it can fairly be done" (*Brown v. Guild*, 90 U.S. (23 Wall.) 181, 226 (1874))—would adopt the narrower reading. See A. Deller, *Patent Claims* § 76 (1971 ed. & 1995 Supp.).

v. John Deere Co., 383 U.S. 1, 33 (1966); *Winans v. New York & E.R.R.*, 62 U.S. (21 How.) 88, 100-01 (1859); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387 (Fed. Cir. 1992); *Howes v. Medical Components, Inc.*, 814 F.2d 638, 645 (Fed. Cir. 1987).⁵ If, after this extensive examination, a genuine uncertainty about meaning remains, the statutory requirement that a claim "distinctly" identify the invention cannot be met. Thus, the patent statute, indeed petitioners' very notion of a common community understanding of particular terms, negates the essential premise of petitioners' argument—that a valid patent claim can present a factual issue as to its meaning on which reasonable jurors could come to opposite conclusions.⁶

2. The distinctively strong statutory requirement of precision is needed to carry out a long-recognized policy: a patent claim must "give fair warning to persons in the art of what will constitute infringement." D. Chisum, *Patents* § 803[3] (1995). Thus, this Court has explained: "The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.'" *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. at 232; *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. at 369. And the Court has emphasized that "[t]he claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention

⁵ The prosecution history is on file with and publicly available from the Patent and Trademark Office. 37 C.F.R. § 1.11(a).

⁶ Contrary to the suggestion of *amicus* Litton (Br. 18), the interpretation of claim language is not left to the jury under the "doctrine of equivalents" (which itself is the subject of a recent *en banc* decision of the Federal Circuit, from which certiorari has been sought, *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (1995), petition for certiorari filed, No. 95-728 (Nov. 6, 1995)). Whatever issues are presented by allowing infringement to be based on a finding as to what is "equivalent" to the plaintiff's patent claim, the threshold requirement is that the claim itself be precisely defined so as to establish a clear benchmark for the equivalence comparison.

is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." *White v. Dunbar*, 119 U.S. 47, 51-52 (1886).

These fundamental statutory policies make clear that a valid patent claim cannot allow the sort of ambiguity on which petitioners rest their contention that claim interpretation presents a factual issue for a jury. Any claim so ambiguous as to present two reasonable interpretations cannot provide the statutorily required clear notice to the world as to what precisely is off limits to all but the patentee. Granting to a jury (or any finder of fact) the power to "resolve" some residual ambiguity in a valid claim—some indefiniteness as to how the relevant terms are understood by the relevant skilled community—strips the claim of its fundamental function of furnishing clarity to the public. Petitioners' position, in short, would undermine the "uniformity and definiteness which Congress called for in the 1952 Act." *Graham*, 383 U.S. at 18.

B. A Patent Claim Is an Official, Institutional, Governmental Imposition of Legal Obligations on the World at Large and As Such, Unlike a Contract But Like a Statute, Must Have a Public Meaning to Be Determined by a Court.

1. Even if extrinsic evidence is required in an infringement case, the interpretation of a patent claim is a matter of law because a patent claim, like a statute, is a governmental act imposing nonconsensual public obligations. See *Markman*, 52 F.3d at 987. Once a patent issues, the public at large, including complete strangers to the governmental proceeding that produced the patent, is under a new federally imposed duty to avoid making, using, or selling the patented invention (35 U.S.C. § 271) and is generally charged by law, as with a statute, with knowledge of what it may not do. See *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 478 (1974) (intent is not an element of infringement liability). The issuance of a patent through formal governmental processes thus sets a generally applicable standard of conduct. And the inter-

pretation of its meaning involves "law declaration": as with a statute, fashioning a "more precise definition" is "a further exercise of the function of law declaration," because it is "concerned with general propositions," and "the answer is good not only for this case but for all other like cases," thus adding to the clear guidance that patent law demands. H. Hart & A. Sacks, *The Legal Process* 352 (W. Eskridge & P. Frickey eds. 1994); see also Monaghan, *Constitutional Fact Review*, 85 Colum. L. Rev. 229, 235 (1985) ("The important point about law is that it yields a proposition that is *general* in character."); *Thompson v. Keohane*, No. 94-6615 (Nov. 29, 1995), slip op. 13-16.

This analogy to statutes and other public law is in no way defeated by the fact that a patent involves technical concepts or terms requiring interpretation on the basis of non-legal materials. Cf. Pet. Br. 45. Not only are federal judges likely to be more adept at such interpretation than juries, but the need to discover the accepted meaning of technical or other non-legal terms simply does not distinguish patents from statutes. This Court has explained that "where Congress has used technical words or terms of art, 'it [is] proper to explain them by reference to the art or science to which they [are] appropriate.'" *Corning Glass Works v. Brennan*, 417 U.S. 188, 201 (1974); see also *United States v. Cuomo*, 525 F.2d 1285, 1291 & n.17 (5th Cir. 1976) (collecting authorities). And courts may rely, as this Court did in *Corning*, on live testimony or documentary evidence, such as specialized dictionaries, to discern the technical meaning in the relevant field. *Corning*, 417 U.S. at 202; see *United States v. Easter*, 981 F.2d 1549, 1558 (10th Cir. 1992), cert. denied, 113 S. Ct. 2448 (1993); *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1172 (Fed. Cir. 1993).⁷

⁷ General and specialized dictionaries are routinely used by this Court and other courts, even without formal admission as evidence (see *In re Envirodyne Industries, Inc.*, 29 F.3d 301 (7th Cir. 1994)) and certainly without transforming the interpretive task into a

Nothing about the need to determine the meaning of initially unfamiliar terms, through an examination and evaluation of the objective evidence of how they are understood in the relevant community, disqualifies the task as law interpretation. Uncovering the accepted understanding in the relevant community retains its basic legal character even when the relevant community is a technical or unfamiliar one. Indeed, that task is just what federal judges are charged with doing by Federal Rule of Civil Procedure 44.1, which declares that the determination of *foreign* law—often, of course, in a foreign language and from an unfamiliar legal culture—is a matter of law for the judge, even when conflicting evidence is presented. *See, e.g., United States v. Mitchell*, 985 F.2d 1275, 1280 (4th Cir. 1993).

2. The two dissenting judges below relied on a different analogy—that of contract interpretation. *Markman*, 52 F.3d at 1000-01 (Newman, J., dissenting); *id.* at 997 (Mayer, J., concurring in the judgment). Petitioners virtually concede that this analogy may be inapt, invoking it only briefly in historical terms. Pet. Br. 44.¹ And the analogy is, indeed, inconsistent with their view of

"factual" question for a factfinder. *See, e.g., Eastern Airlines, Inc. v. Floyd*, 499 U.S. 530, 536-38 (1991); *Air France v. Saks*, 470 U.S. 392, 400 (1985); Note, *Looking It Up: Dictionaries and Statutory Interpretation*, 107 Harv. L. Rev. 1437, 1447 (1994). Declarations by human beings about meaning, i.e., relevant community understandings, are no different as an evidentiary matter from the declarations in a text.

¹ The metaphor of a patent as a "bargain" between the patentee and the government can, of course, be applied whenever any person, in exchange for some act (participation in a federal program), acquires statutory rights and obligations; interpreting those rights and obligations does not thereby become a matter of fact. The metaphor of contract also has sometimes been used to describe statutory "deals" as well. *See Easterbrook, The Supreme Court, 1983 Term—Foreword: The Court and the Economic System*, 98 Harv. L. Rev. 4, 14-15 (1984) (in one approach to statutory construction, "the judge treats the statute as a contract").

what the "fact" is that a court interpreting a patent claim is supposed to be discerning.

As the Federal Circuit explained (*Markman*, 52 F.3d at 985), in the law of private contracts, when the judge cannot determine the meaning of a written contract (which is concededly a question of law up to the point of ambiguity), the question of community understanding is displaced by the uniquely contract-law inquiry into subjective intent: what did the parties intend to agree to? *See, e.g.,* Restatement (Second) of Contracts §§ 201 & Comment a, 202, 212 & Comment d, 220 & Comment b (distinguishing objective, general usage or community understanding, on one hand, from particular understanding or intent defining agreement, on the other, and deeming latter to control if different from former). But petitioners now concede that such subjective intent (though it may play estoppel or other roles) is not the "fact" that defines the meaning of a patent.⁹ The "fact" instead is quite different: it is the understanding of persons skilled in the relevant art—a matter determinable by a judge using the same materials as those used for other forms of law interpretation. *See Bristow v. Drake Street Inc.*, 41 F.3d 345, 352 (7th Cir. 1994) ("evidence about what words, phrases, etc. mean to a community, not merely to a pair

⁹ Not only would any subjective, mutual intent of the patentee and the government be difficult to ascertain and awkward to apply (the government is rarely a party to infringement litigation, and testimony from examiners is only rarely permitted), but making patent interpretation turn on such intent would be incompatible with the patent policy of clear initial notice to the public at large, as well as with the rule requiring all business with the Patent and Trademark Office to "be transacted in writing." 37 C.F.R. § 1.2; *ibid.* (PTO action "will be based exclusively on the written record"; "[n]o attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt"); 37 C.F.R. pt. 15a.

In a private contract dispute, where general public notice is not key, the ability of the parties to make a factual showing of shared bilateral subjective intent allows a written contract to remain valid despite a broad measure of facial indefiniteness. *See, e.g.,* Restatement (Second) of Contracts § 33 & comments.

of individuals[,] . . . is evidence about a public, not a private, language—evidence that is the equivalent, really, of a specialized dictionary”).

Not surprisingly, this Court has distinguished contract rights from “the rights which are given to the inventor by the patent law and which he may assert against all the world through an infringement proceeding.” *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 514 (1917). (The Court has made a similar distinction elsewhere. *E.g.*, *American Airlines, Inc. v. Wolens*, 115 S. Ct. 817, 824 (1995) (distinguishing government-imposed obligations from those voluntarily assumed).) After all, the public duties at issue in patent-infringement actions, created by the government through issuance of the patent, are in no sense voluntarily undertaken or defined. Rather, they are imposed and defined by federal law through formal action of the Patent and Trademark Office, to which the infringement-suit defendant is a stranger.¹⁰ Such a government-imposed public duty, unlike a private party’s agreed-to undertaking, is itself law.

Any analogy to *private*-contract law also fails to aid petitioners for another reason: it simply cannot establish what petitioners are trying to suggest, namely, that finders of fact are routinely given the task of resolving ambiguities in government written instruments, and the same practice therefore can comfortably be followed with patent interpretation. In *government* contract law, however, that is decidedly not the established practice for dealing with

¹⁰ Petitioners’ *amicus* Litton invokes an analogy to a deed (Litton Br. 21), but the decision it relies on for how deeds are interpreted, *Reed v. Proprietors of Locks and Canals*, 49 U.S. (8 How.) 274 (1850), makes only the familiar point that, because a deed is a written bilateral conveyance from one party to another, the boundaries of the property conveyed in the deed are to be determined according to “the intention of the parties.” *Id.* at 288; *see id.* at 289; J. Cribbet, *Principles of the Law of Property* 168, 171 (2d ed. 1975). With subjective intent not the standard for interpreting patent rights (which are not bilateral, but run against the world), the deed analogy adds nothing to, and is no stronger than, the contract analogy.

ambiguity. Rather, the Federal Circuit (like its predecessors) has declared that “contract interpretation is a question of law,” not a matter of fact. *Wright Constr. Co. v. United States*, 919 F.2d 1569, 1571 (Fed. Cir. 1990).¹¹ And if an ambiguity is found (after examination of disputed testimony about the contract’s meaning), resolution of that ambiguity is *not* remitted to a factfinder; instead, the inquiry turns to whether the plaintiff relied on its (reasonable) interpretation of the (government-drafted) contract in submitting its bid. *See, e.g.*, *Fruin-Colnon Corp. v. United States*, 912 F.2d 1426, 1430 (Fed. Cir. 1990); *Edward R. Marden Corp. v. United States*, 803 F.2d 701, 705 (Fed. Cir. 1986). Even in the contract setting, then, it is hardly a familiar step to deem the interpretation of a *government* written instrument a matter of fact for adjudication, much less a jury question. Without even contract law as a reliable precedent in the government context, it would be extraordinary, if not entirely novel, to take that step for patent claims.¹²

¹¹ The question arises, for example, on review of contract interpretations by the Board of Contract Appeals, whose factual findings (but not legal rulings) are subject to substantial-evidence review, 41 U.S.C. § 609(b).

¹² Petitioners’ reference to federal tariffs provides no more aid to the suggestion that the meaning of patent claims is a factual question for juries. Pet. Br. 43-44. This Court explained in *Great Northern Ry. v. Merchants’ Elevator Co.*, 259 U.S. 285, 291-92 (1922), that “[e]very question of the construction of a tariff is deemed a question of law.” The Court then also said, after explaining that contract cases sometimes require factual determinations as to disputed meanings, that the preliminary determination of the specialized meaning of tariff terms was a matter for the Interstate Commerce Commission. 259 U.S. at 292. In a context where the resolution of ambiguity is a task for a national administrative agency, however, nothing turns on whether the resolution is called a factual or legal question: *agency* resolution produces a single, nationwide, uniform answer, to which the courts give deference regardless of its characterization as law or fact. *See, e.g.*, *Association of Data Processing v. Board of Governors*, 745 F.2d 677, 685 (D.C. Cir. 1984) (per Scalia, J.) (equivalence of “substantial evidence” and “arbitrary and capriciousness” tests).

C. This Court's Precedents Support the Federal Circuit's Holding.

Although petitioners and their *amici* argue that this Court's precedents establish that interpretation of a patent claim is a matter of fact for the jury (Pet. Br. 31-37; Litton Br. 15-17; Exxon Br. 7-10), that assertion is incorrect. In fact, petitioners and their *amici* have cited not a single decision of this Court that assigned to a jury, as a finder of fact, the task of resolving an ambiguity in a patent claim so as to decide what the claim *means*. To the contrary, this Court has often declared that determining the meaning of claim language is a matter of law and has often performed that task, without deferring to any finding of fact on the question. And each of the cited authorities supposedly standing for the contrary proposition in fact confirms that determining the meaning of a patent claim, as opposed to other adjudicative tasks, is a matter of law.

1. Petitioners themselves effectively acknowledge that numerous decisions of this Court have both stated that claim interpretation is a matter of law for the judge and actually interpreted the patents' meaning independently. Pet. Br. 34-35, citing and quoting *Heald v. Rice*, 104 U.S. 737, 749 (1881), *Market Street Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895), *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904), *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848), *Winans v. New York & Erie R.R.*, 62 U.S. (21 How.) at 101, and *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. (5 Otto) 274, 276 (1877). Petitioners try to write off all of this authority on the ground that none of the cases actually involved a genuine dispute about meanings that were unclear. Pet. Br. 34-35. But the cases have only to be read to see that "technical" issues were often involved, and yet the Court has consistently interpreted patent claims, thus confirming that the meaning of patent claims is a matter of law (for either or both of the reasons set forth in Points A and B, *supra*).

The same principle is confirmed by the decision principally relied on by petitioners' *amicus* Litton (Litton Br. 15-16)—which petitioners assert "simply do[es] not address the question presented here" (Pet. Br. 35 n.18)—namely, *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225 (1853). The Court there expressly held that "[t]he construction of the claim was undoubtedly for the court"; that the judge properly concluded that the *meaning* of the patent claim was simply to cover all the parts of the machine that were "essential" to produce the specified result; and that the jury was of course properly given the factual question of which parts were essential. *Id.* at 226. Thus, in full accord with the Federal Circuit's ruling here, *Silsby* carefully distinguished the question of the meaning of the words of the patent—a legal issue—from the factual questions, as to how particular machines would work, that remained once the task of interpretation was exhausted.¹⁸ Similarly, in *Bates v. Coe*, 98 U.S. (8 Otto) 31, 38-39 (1878), this Court explained that "[i]n construing patents, it is the province of the court to determine what the subject-matter is" *See also Markman*, 52 F.3d at 978 n.9 (noting decisions from this Court construing patents in equity cases, without deferential review of trial court construction).

¹⁸ Litton relies, as well, on *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854), in which, as petitioners note, "[t]he meaning of [the pertinent] term was undisputed" (Pet. Br. 35 n.18). In fact, the Court in *Winans* said that, in a patent-infringement trial, "two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used, or sold by the defendants. . . . The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury." *Id.* at 338. After the Court construed the patent to cover a particular mode of operation in substance (*id.* at 341, 343), the jury was assigned the task of deciding whether the defendant's product was so close to the patentee's "as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention." *Id.* at 344.

2. Against this weight of authority, petitioners rely for asserted affirmative authority on only two decisions of this Court, *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1870), and *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872). Pet. Br. 31-33; see also Litton Br. 16. But these two decisions do not remotely hold that determining the meaning of patent language is a task for the jury. If anything, they indicate the opposite.

Thus, in *Bischoff*, the Court held that a jury was to be given the task of comparing the two inventions, noting—at a time before the patent “claim” came to define the invention—that “the outward embodiment of the terms contained in the patent is the thing invented.” 76 U.S. at 815. The Court then took care to note: “This view of the case is not intended to, and does not, trench upon the doctrine that the construction of written instruments is the province of the court alone. It is not the construction of the instrument, but the character of the thing invented, which is sought in questions of identity and diversity of inventions.” *Id.* at 816 (emphasis in original). The Court thus explicitly distinguished the job of interpreting the patent language from the separate job of deciding, as a factual matter, whether the defendant’s product met the description of the patent thus interpreted.¹⁴ That distinction confirms, rather than undermines, the Federal Circuit’s holding that determining the meaning of the patent is a matter of law.

Tucker v. Spalding is no more helpful to petitioners. The issue there was whether the plaintiff’s patent (for a sawing process) was novel or, instead, was invalid because of an earlier invention. 80 U.S. at 454-56. The Court, saying nothing whatever about any issue as to the meaning of any patent language but instead declaring that the case was governed by *Bischoff*, held that the

¹⁴ See also *Coupe v. Royer*, 155 U.S. 565, 579 (1895) (“the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant”).

defendant was entitled to give the jury the prior patent to determine whether “what [the earlier invention] actually did, is in its nature the same as sawing, and its structure and action suggested to the mind of an ordinary skillful mechanic [the] double use” characteristic of the plaintiff’s machine. *Id.* at 455-56. This question of novelty, on its face a factual matter, presents no issue as to the meaning of language in the patent. Cf. Exxon Br. 10-11 (conflating question of meaning with question of level of ordinary skill in the art).

These and similar cases from the era tend to concentrate on the underlying factual aspects of infringement because they were decided under a set of patent-law principles quite different from those prevailing today. At least before the latter years of the Nineteenth Century, the “claim” of a patent, where it existed at all, was not nearly as detailed, precise, and important as it is today: it was not taken as *prescribing*, but merely as *describing*, the protected invention.¹⁵ As a result, although the courts interpreted the meaning of such language as there was, that language, because of its generality and imprecision, did not carry the inquiry into infringement very far. Any

¹⁵ “[T]he courts for a long time did not regard the particular formulations chosen by the inventor to express his claim and distinguish his invention from the prior art as the definitive measure of the scope of the patent.” Woodward, *Definiteness and Particularity in Patent Claims*, 46 Mich. L. Rev. 755, 760 (1948). Thus, the Court’s 5-4 decision in *Winans v. Denmead*, 56 U.S. (15 How.) at 343, treated the claim as merely the best embodiment, rather than definition, of the true invention. See Woodward, *supra*, at 762-63. Until the latter years of the Nineteenth Century, the Patent Office and the courts allowed claims of a few lines that did little more than refer back to the specification for the description of the invention; and in litigation, “the claim was not used to measure infringement,” but, instead, the question of infringement was “whether the two things, one of which is said to be an infringement upon the other, are the same, or different.” Lutz, *Evolution of the Claims of U.S. Patents*, 20 J. Pat. Office Soc’y 134, 147 (1938); see, e.g., *id.* at 134-47, 459-62 (quoting numerous such simple claims); *id.* at 462-66 (Patent Office practice during 1836-1870); *Silsby v. Foote*, 55 U.S. (14 How.) at 226 (representative claim).

effort to refine the *meaning* of patent language was quickly exhausted, and much work was left to the factfinder to apply that fully construed, but still imprecise, language—which often just described a core mode of operation or function “in substance.”

After the 1870 Act, however, the Court began to establish with new force a quite different principle of patent law, one that had previously been invoked on occasion (e.g., *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853)) and that found support in the 1836 Act but was embodied much more explicitly in the 1870 Act: that the patent claim *defines* the protected invention and must, in order to be valid, be precise and definite.¹⁶ E.g., *Merrill v. Yeomans*, 94 U.S. (4 Otto) 568, 570, 573-574 (1876)¹⁷; *Keystone Bridge Co.*, 95 U.S. at 278-79¹⁸;

¹⁶ See D. Chisum, *Patents* § 8.02[2] (1995); A. Deller, *Patent Claims* § 4, at 9 (2d ed. 1971) (“The idea that the claim is just as important if not more important than the description and drawings did not develop until the Act of 1870 or thereabouts [see Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198]. . . . The developing importance of the claims, first mentioned in the Act of 1836 [Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117], then later regarded by the Act of 1870 as of equal importance with the description of the invention and the drawings, has since resulted in the claim being regarded as by far the most important part of a patent.”).

¹⁷ The Court in *Merrill* explained that it was time for a change in patent law: there was no longer any “excuse for ambiguous language or vague descriptions. . . . The genius of the inventor, constantly making improvements in existing patents,—a process which gives to the patent system its greatest value,—should not be restrained by vague and indefinite descriptions of claims in existing patents from the salutary and necessary right of improving on that which has already been invented.” 94 U.S. at 573-74 (emphasis added).

¹⁸ The Court in *Keystone* explained that the requirement of a “claim,” separate from the description contained in the specification, “was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of previous inventions, and a comparison thereof with that claimed by him. This duty is now cast upon the Patent Office. There his claim is, or is supposed to be, examined, scrutinized, limited and

see *McClain v. Ortmyer*, 141 U.S. 419 (1891). “As a natural result of the general establishment of the claims of a patent as the primary measure of the scope of the patent grant,” the practice of the Patent Office and of patent attorneys gradually but markedly shifted from the former “central claiming” regime to the modern “peripheral claiming” regime, in which the outer boundary (rather than just the core) of the patent monopoly is laid out in precise detail. Woodward, 46 Mich. L. Rev. at 764 (footnote omitted); see Hantman, *Doctrine of Equivalents*, 70 J. Pat. & Trademark Off. Soc’y 511, 522 (1988); *Markman*, 52 F.3d at 996 (Mayer, J., concurring in the judgment). In the decades leading up to the enactment of the current Patent Act in 1952, this Court, with ever increasing consistency, insisted on precision and definiteness of patent claims, which, it explained, “‘measure the invention.’” *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. at 369; *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. at 236; see D. Chisum, *Patents* § 8.02[3] (1995).

Under this modern regime, the interpretation of patent-claim language takes on far greater importance than under the former regime. Where the language is much more precise and detailed, and where it is taken to *define* the invention, that meaning will leave fewer factual questions as to whether a defendant’s product is one of the things described in the (now precise) patent claim. But nothing in the earlier precedents’ focus on the factfinding judgments left in applying patent terms after they have been fully interpreted—an inevitable focus, given the imprecision of the patent terms—in any way casts doubt on the *legal* character of the initial task of interpreting patent terms, a character those decisions in fact affirm. Nor, of course, do those decisions cast doubt on Congress’s power to insist that patent terms be more precise so as to di-

made to conform to what he is entitled to. . . . When the terms of a claim in a patent are *clear and distinct*, as they always should be, the patentee, in a suit brought upon the patent, is bound by it.” 95 U.S. at 278 (emphasis added).

minish the scope for factfinding judgment in applying them.¹⁹

D. Relevant Functional and Practical Analysis Supports the Federal Circuit's Holding.

The correctness of the Federal Circuit's ruling is further confirmed by application of the law/fact analysis set forth in *Miller v. Fenton*, 474 U.S. 104 (1985). There, this Court explained: "In the [28 U.S.C.] § 2254(d) context, as elsewhere, the appropriate methodology for distinguishing questions of fact from questions of law has been, to say the least, elusive. . . . [T]he Court has yet to arrive at 'a rule or principle that will unerringly distinguish a factual finding from a legal conclusion.' . . . At least in those instances in which Congress has not spoken and in which the issue falls somewhere between a

¹⁹ Petitioners' reliance on *Washburn v. Gould*, 29 F. Cas. 312 (C.C.D. Mass. 1844), see Pet. Br. 27, is misplaced. There, Justice Story, sitting as Circuit Justice, recognized that the issue of enablement by the specification (a fact question) was a different issue from that of definiteness of the claim and proceeded to construe the claim as a matter of law (29 F. Cas. at 318); he stated that "the court was bound to state what in point of law the invention claimed by the patentee was . . . so far as the construction of the words of the patent, and specification is concerned" (*id.* at 325 (emphasis added)); he indicated that he did not rely on the notion that the jury may judge the meaning of technical phrases (*ibid.*); and he made clear that the factual questions for the jury, in determining infringement, were what parts of the patentee's claimed machine were actually new and whether the defendant used such substantial parts (*ibid.*). Nothing in *Washburn*, in short, holds that determining the meaning of a patent claim is a matter of fact for the jury.

Petitioners' reliance on a passing statement in a lengthy jury instruction given in *Ransom v. New York*, 20 F. Cas. 286, 289 (S.D.N.Y. 1856), see Pet. Br. 28, needs little response. Even aside from the minimal weight of such authority, it is not clear that the court actually gave the question of the technical meaning of the patent claim to the jury. In any event, on review, this Court remanded for a new trial (though for lack of a proper record, the Court was "unable to test the correctness of the construction of the patent by the court below"). *City of New York v. Ransom*, 64 U.S. (23 How.) 487, 488, 491 (1860).

pristine legal standard and a simple historical fact, the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question." *Id.* at 113-14. The Court then found the "voluntariness" of a confession not to be a question of fact, based on (a) precedent, (b) the need to ensure that the answer in any case is compatible with the overall legal system's presumption of innocence and non-inquisitorial character, and (c) the relative unimportance to this issue of in-court credibility of witnesses. 474 U.S. at 115-18. (The Court recently followed a similar analysis in holding that whether a suspect is "in custody"—a question whose resolution is not based on subjective intent but rather on an objective standard—is a question of law. *Thompson v. Keohane*, No. 94-6615 (Nov. 29, 1995).)

A similar analysis in this case supports the Federal Circuit's ruling that patent-claim interpretation—itsself plainly not a matter of simple historical fact, *i.e.*, a concrete occurrence at a particular time, "what happened" (*Thompson*, slip op. 11)—is a question for the court. To begin with, as just discussed, precedent provides strong support for the Federal Circuit's ruling. Moreover, the Federal Circuit's ruling is (for the reasons discussed in Points A and B, *supra*) more compatible with the overall patent system—both with the statute's demand for precision, definiteness, and uniformity and with the character of patent grants imposing general duties on the public at large through formal agency action. Further, a jury does not have any peculiar advantage in determining community understanding as to the meaning of a term in a patent claim. In particular, it is hard to imagine how a finding of a shared understanding of meaning in the relevant skilled community could come down to an assessment of in-court demeanor—as opposed to an evaluation of accumulated documentary evidence and the substance of transcribed testimony.

Practical considerations bearing on the "sound administration of justice" support this result as well. Petitioners'

suggestion that interpretation of "technical" terms is a task for the jury creates an impractical division of labor for what ultimately is one task. Petitioners do not, and could not, dispute that it is for the judge to interpret patent claims insofar as the task requires application of the blizzard of established and developing special rules of patent law defining the effect of particular terms and phrasings. See Woodward, 46 Mich. L. Rev. at 765 ("the claims of patents have become highly technical in many respects as the result of special doctrines relating to the proper form and scope of claims that have been developed by the courts and the Patent Office from time to time"); see generally A. Deller, *Patent Claims* (2d ed. 1971 & 1995 Supp.); D. Chisum, *Patents* § 8.06 (1995). Yet petitioners' position would require the judge to draw a line between the "technical" and "non-technical" terms in patent claims so as to assign interpretation of the former, but not the latter, to the jury. The introduction into the law of such a hard-to-discern line would complicate the workings of the patent system, fostering excessive litigation and undermining the statutory policy of certainty and clarity in the scope of patent monopolies.

Inevitably, any line based on whether or not an interpretation is of a "technical" term will vary from judge to judge. One judge, adept in the relevant technical field, may not even have a need for extrinsic evidence on the relevant community understanding of the term, but may find the meaning clear from the judge's own knowledge or with aid of relevant texts that the judge comprehends. A second judge, less familiar with the technical field, may need other extrinsic evidence to become informed of the matter. The task of interpretation, however, cannot sensibly be for the judge in the one case and for a jury in the other.

Petitioners object that, if claim interpretation is a matter of law for the judge, juries may have too little to do in infringement litigation. Pet. Br. 17 n.8. This is an absurd objection. What work there is for a jury turns entirely on the substance of the governing legal standard

and what factual questions the standard presents. See F. James & G. Hazard, *Civil Procedure* § 7.10, at 337 (3d ed. 1985). A legal standard imposing some form of strict liability, thus eliminating the factual inquiry required by an intent-based standard, is not to be condemned on that account.

Indeed, whether as a policy matter or as a constitutional matter, there is no virtue in making work for juries. To the contrary, it flies in the face of reason and policy to treat as a vice, rather than a virtue, a statutory standard that reduces the necessity and extent of costly litigation over factual issues. See, e.g., *Central Bank v. First Interstate Bank*, 114 S. Ct. 1439, 1454 (1994); *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986) (summary judgment should be used to implement Fed. R. Civ. P. 1's commitment to securing the "just, speedy and inexpensive determination of every action"); *Fogerty v. Fantasy, Inc.*, 114 S. Ct. 1023, 1030 (1994) ("Because copyright law ultimately serves the purpose of enriching the general public through access to creative works, it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible.")

E. The Federal Circuit's Holding Is Consistent With the Seventh Amendment.

There is no precedent of this Court stating whether patent-claim interpretation must, as a matter of Seventh Amendment law, be assigned to a jury: petitioners acknowledge that this Court has not "addressed the Seventh Amendment explicitly." Pet. Br. 21. That absence of authority—notwithstanding this Court's ample body of precedent supporting the Federal Circuit's holding that interpreting a patent claim is a legal task for the judge—is readily understandable. Given all of the foregoing reasons why the Federal Circuit's holding is sound as a non-constitutional matter, nothing whatever in the Seventh Amendment requires a different result.

1. Initially, treatment of the task of discerning the meaning of a patent claim as a legal question is consistent with the Seventh Amendment because, for all of the rea-

sons stated above, the issue properly falls on the law side of the fact/law distinction.²⁰ Indeed, no precedent identified by petitioners or their *amici* holds that the determination of the *meaning* of a written instrument—which is different from subjective intent and not a pure historical fact—is *constitutionally required* to be treated as a question of fact. Still less is there any precedent declaring such a requirement for the interpretation of a legal instrument issued by formal government action to impose obligations on the world at large, including strangers to the government proceeding.

The second clause of the Seventh Amendment (*see* Pet. Br. 31 n.16; Litton Br. 12-13) adds nothing to the analysis. For cases tried in federal court, it merely protects the right granted in the first clause, by insisting that appellate courts, and the trial judges themselves, follow the common-law principles for setting aside determinations that have been made by a jury. *See, e.g., Baltimore & Carolina Line*, 295 U.S. at 657. The clause has never been read, and cannot sensibly be read, as imposing any requirement as to what issues must be tried to a jury in the first place: the clause addresses itself only to the post-trial process, declaring that a fact that has been “tried by a jury” (as required by law) may not be “re-examined” except under common-law rules. Moreover, and in any event, nothing in the second clause, which speaks explicitly of any “fact” tried by a jury, creates a different line from the fact/law distinction of the first clause—which, as noted, does not aid petitioners’ Seventh Amendment argument.

2. The Seventh Amendment presents no obstacle to the Federal Circuit’s ruling even aside from the fact/law

²⁰ The Court has said: “The limitation imposed by the amendment is merely that . . . the ultimate determination of issues of fact by the jury be not interfered with.” *In re Peterson*, 253 U.S. 300, 310 (1920); *see, e.g., Baltimore & Carolina Line*, 295 U.S. at 657; *Walker v. New Mexico & S.P.R.R.*, 165 U.S. 593, 596 (1897). The Judiciary Act of 1789, 1 Stat. 73, gave fact issues to juries (§ 9 (district courts); § 12 (circuit courts); § 13 (Supreme Court)) and barred appellate “reversal . . . for any error of fact” (§ 22).

distinction. This Court has made clear that the Seventh Amendment does not rigidly insist on this distinction where proper application of the controlling substantive law requires judicial determination of matters in dispute. Thus, the Court held in *New York Times Co. v. Sullivan*, 376 U.S. 254, 285 n.26 (1964), that “[t]he Seventh Amendment[’s] . . . ban on reexamination of facts does not preclude us from determining whether governing rules of federal law have been properly applied to the facts,” and subsequently in *Bose Corp. v. Consumers Union of United States*, 466 U.S. 485, 511 (1984), that independent appellate court judgment was permitted by the Seventh Amendment on whether there was “actual malice”—an issue that does involve a question of simple historical fact because it asks about the defendant’s subject state of mind, namely, knowledge or suspicion of falsity. *See Bose Corp.*, 466 U.S. at 511 n.30 (meaning of actual malice); *id.* at 517-18 (Rehnquist, J., dissenting) (actual malice a fact question, a proposition not denied by majority); *cf. Pullman-Standard v. Swint*, 456 U.S. 273 (1982) (state of mind a matter of fact). More broadly, the Court has long made clear that the Seventh Amendment’s commitment of fact questions to juries, with its bar on appellate reexamination, does not apply “where a conclusion of law as to a Federal right and a finding of fact are so intermingled as to make it necessary, in order to pass upon the Federal question, to analyze the facts.” *Fiske v. Kansas*, 274 U.S. 380, 385-86 (1927); *see Bose Corp.*, 466 U.S. at 506 & n.24, 508 & n.27; *New York Times Co.*, 376 U.S. at 285 n.26; *Haynes v. Washington*, 373 U.S. 503, 515-16 (1963); *Aetna Life Ins. Co. v. Dunken*, 266 U.S. 389, 394 (1924).

These principles apply to the question of patent-claim interpretation presented in this case and thus independently dispose of petitioners’ Seventh Amendment argument. The interpretation of a patent, concededly a matter of federal right, is, at a minimum, “intermingled” with any “fact” question as to the relevant community understanding of the meaning of particular terms. And given the Patent Act’s demand for clarity and uniformity, proper applica-

tion of a federal patent monopoly—what it restricts and, just as important, what it leaves unrestricted—requires judicial freedom to examine any “fact” determination as to the meaning of particular terms to ensure true definiteness, and proper definition, of the patent claim. See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150, 151, 162 (1989) (patent law policy defeated by improper extension of patent monopoly).

3. Finally, even if the pre-1791 background of the Seventh Amendment were solely determinative here, not only as to what causes of action—statutory as well as nonstatutory—were “suits at common law” but as to what issues in such a case were for the jury, petitioners cannot prevail.²¹ Most generally, contemporaneous authority stated that the meaning of written documents was a matter of law for the judge, not a matter of fact for a jury. *Macbeath v. Haldimand*, 99 Eng. Rep. 1036, 1040 (K.B. 1786) (“there was no evidence which was proper for their [the jury’s] consideration; for the evidence consisting altogether of written documents and letters which were not denied, the import of them was a matter of law and not of fact”). That principle on its face requires rejection of petitioners’ view.

Petitioners fare no better when they attempt to show that *patent* interpretation was treated in English law prior to 1791 as a matter of fact for the jury. See Pet. Br. 22-26. Indeed, they are able to invoke precedent in support of their position only by lumping together a host of different issues in patent law and pretending that they are the same. In particular, their invocation of precedent makes the fundamental mistake of failing to distinguish definite-

²¹ There is reason to doubt any such effect, over and above the points described above. The role of the jury was not so clearly defined as to make a rigid historical approach sensible. See, e.g., *Galloway v. United States*, 319 U.S. 372, 390-91 (1943). Even law questions were occasionally viewed, at the time, as within the right of the jury to decide. See, e.g., *Georgia v. Brailsford*, 3 U.S. (3 Dall.) 1, 4 (1794); Note, *The Changing Role of the Jury in the Nineteenth Century*, 74 Yale L.J. 170, 173-74, 179 (1964). That proposition, of course, has long been rejected.

ness of claim language from enablement. See page 5, *supra*. Once those distinct issues are separated, it is clear that none of petitioners’ pre-1791 English precedents supports their view that determining the *meaning* of the terms of a patent—much less of a (then-nonexistent) “claim” required by law to *define* the precise terms of the invention—presents a question of fact for the jury.²²

Petitioners’ lead case, *Liardet v. Johnson* (unreported, K.B. 1778), which was a patent-infringement action brought by the inventors of stucco, has no bearing on the role of a jury in interpreting the meaning of the terms of a patent, much less the meaning of a patent claim. Indeed, there appears to have been no disputed issue either about the scope of the plaintiffs’ invention (let alone about the meaning of any terms in the patent) or about the defendant’s having used the claimed invention. Rather, Judge Mansfield explained that the defendant “‘rested his defence solely upon this question, Whether the plaintiffs’ composition was a new and useful invention, and whether their patent and specification were sufficient to support the exclusive privilege which they claimed?’” Hulme, *On the History of Patent Law in the Seventeenth and Eighteenth Centuries*, 18 Law Q. Rev. 280, 284 (1902). The case thus involved the quite different issues of novelty and enablement, which present factual questions about the concrete nature of particular products and what skilled artisans can do with particular information at particular times.

Petitioners’ second English authority lends no more aid to their argument. Pet. Br. 24. In *Arkwright v. Nightingale*, Davies Patent Cases 37 (Common Pleas 1785), there was again no issue as to the meaning or scope of the terms of a patent. Rather, the court explained that the sole issue for the jury was the adequacy of the disclosure in enabling the machine to be replicated. *Id.* at 56. The

²² “Prior to 1790 nothing in the nature of a claim had appeared either in British patent practice or in that of the American states.” Lutz, 20 J. Pat. Office Soc’y at 134; see *Markman*, 52 F.3d at 984 (patent claim first developed in United States).

court instructed the jury that the only question before it was whether to believe the several witnesses who testified that they had, in fact, constructed the machine based on the patent specification (thus proving its intelligibility): "the only question for your consideration is, whether these five men have made the machine?" *Id.* at 60. That question, undeniably a factual one, is entirely different from the question whether a relevant community has a shared understanding about the meaning of particular language.

Petitioners' third authority is no different. Pet. Br. 24. In *Turner v. Winter*, 1 T.R. 602, 99 Eng. Rep. 1274 (K.B. 1787), there was simply no question of resolving some apparent ambiguity in the terms of a patent so as to determine what the terms meant. Rather, the question, as in *Liardet*, was whether the patent's terms provided clear instruction of how to produce the invention—for, if not, the vagueness of the disclosure would render the patent void. 1 T.R. at 605-06; 99 Eng. Rep. at 1276-77. There is thus no parallel between the factual question in that case—what skilled artisans were capable of doing with certain information—and the question of interpreting a patent's meaning.

Petitioners also cite W. Hands, *The Law and Practice of Patents for Inventions* 17 (1808), to show the pre-1791 law, but nothing in the text says that the jury is to decide the meaning of the terms of a patent. Pet. Br. 25. The quoted page says that (after legal objections are resolved) the case is submitted to the jury, but it says nothing whatever about what particular issues are submitted. Equally unsupportive of petitioners' reading of English law in the late Eighteenth Century is its misleading quotation from F. Buller, *An Introduction to the Law Relative to Trials at Nisi Prius*, ch. VII, at 76 (6th ed. 1791). See Pet. Br. 25. As respondents noted at the petition stage, quoting the cited passage more fully (Br. in Opp. 9 n.7), the source says nothing to the effect that a jury is to interpret the words of a patent to define its meaning. Rather, in an accurate description of *Liardet*, it says that "[t]he general questions on patents are, 1st,

whether the invention were known and in use before the patent. 2d, whether the specification is sufficient to enable others to make it up" and then adds that "[t]he meaning of the specification is, that others may be taught to do the things for which the patent is granted" Petitioners cannot fairly transform that last sentence into a statement by Buller—much less a well-recognized principle of English patent law—that juries interpret the terms of a patent.²⁰ They are left, in the end, with no proof whatever that the Seventh Amendment codified some pre-1791 principle of English law recognizing that claim interpretation was a matter for juries.

²⁰ In a footnote (Pet. Br. 25 n.13), petitioners cite two additional pre-1791 decisions, but neither lends any support to their point that the interpretation of a patent claim (or indeed of any written document) is a jury question. See *Mayor of Kingston Upon Hull v. Horner*, 1 Cowp. 102, 108, 98 Eng. Rep. 989, 992-93 (K.B. 1774) (factual question of date of port); *Collins v. Sawrey*, 4 Bro. P.C. 692, 699, 2 Eng. Rep. 470, 475 (H.L. 1772) (law case may not be kept by equity court simply because it involves only written evidence). Other authority at the time stated that interpreting written documents was for the judge. *Macbeath v. Haldimand*, *supra*.

Petitioners also cite three English decisions from shortly after 1791. Pet. Br. 26-27, discussing *Hornblower v. Boulton*, Davies Patent Cases 221 (K.B. 1799), *Huddart v. Grinshaw*, Davies Patent Cases 265 (K.B. 1803), and *Bovill v. Moore*, Davies Patent Cases 361 (Common Pleas 1816). But such decisions cannot prove a recognized pre-1791 English principle that the Seventh Amendment could have codified, and in any event, petitioners' own description indicates that the decisions involved only the assignment to juries of plainly factual questions about enablement and novelty. (*Hornblower* also discussed whether the patent was for a machine or an unpatentable mere principle of science, and the judges appear to have answered that question for themselves.) These authorities do not hold that juries are to be assigned the task of determining the meaning of patent language.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

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